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Our Ref.:	1035-311	Date:	August 22, 2006
Application No.:	09/809,095		
To:	Examiner P. Ke		
Firm:	United States Patent and Trademark Office		
Facsimile No.:	571-273-8300		
From:	Michael J. Shea		

Number of Pages (including cover sheet): 9  
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Michael J. Shea  
FACSIMILE OPERATOR

## ATTACHMENT/S:

Notice of Appeal  
Pre-Appeal Brief Request for Review Transmittal Sheet  
Pre-Appeal Brief Request for Review

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Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		<b>Docket Number (Optional)</b> <b>1035-311</b>	
I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office by facsimile to 571-273-8300		Application Number <b>09/809,095</b>	Filed <b>March 16, 2001</b>
on <u>August 22, 2006</u> Signature: <u><i>Michael J. Shea</i></u>		First Named Inventor <b>OHNISHI</b>	
Typed or printed name: <b>Michael J. Shea</b>		Art Unit <b>2174</b>	Examiner <b>P. Ke</b>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> Applicant/Inventor		<u><i>Michael J. Shea</i></u> Signature <b>Michael J. Shea</b>	
<input type="checkbox"/> Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)		Typed or printed name	
<input checked="" type="checkbox"/> Attorney or agent of record <u>34,725</u> (Reg. No.)		<u>703-816-4029</u> Requester's telephone number	
<input type="checkbox"/> Attorney or agent acting under 37CFR 1.34. Registration number if acting under 37 C.F.R. § 1.34 _____		<u>August 22, 2006</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*			
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

OHNISHI

Atty. Ref.: 1035-311; Confirmation No. 8949

Appl. No. 09/809,095

TC/A.U. 2174

Filed: March 16, 2001

Examiner: P. KE

For: OPERATION METHOD FOR PROCESSING DATA FILE

\* \* \* \* \*


August 22, 2006

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW****Facsimile Transmission**

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Michael J. Shea

Pursuant to the OG Notice of July 12, 2005, applicant hereby requests a pre-appeal brief review of this case for at least the following reasons. This Request accompanies a Notice of Appeal.

**Remarks begin on page 2.**

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REMARKS

Claims 1-3, 5-21, 23-25 and 31-37 are pending in this application.

Independent claim 1 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris et al. (U.S. Patent No. 6,097,389) in view of Hirokazu (JP 2000-75984). For the reasons set forth below, Applicants traverse this rejection.

Claim 1 calls for each file icon to be between its corresponding reduced-size image and the second area of the display screen, which second area displays one or more function icons. The file icon has a smaller area than the reduced-size image and, for example, the reduced-size image can be prevented from being covered by the file icon during a drag-and-drop operation of the file icon. In this way, the identity of the reduced-size image can be more easily determined.

The final office action admits that Morris et al. does not disclose this feature. 5/22/2006 Office Action, page 3 ("However Morris fails to teach ... Wherein the reduced-size image for each reduced-size image/file icon pair is displayed so that each file icon is between its corresponding reduced-size image and the second area of the display screen.")

The office action alleges that Hirokazu et al. remedies the deficiencies of Morris et al.

Hirokazu et al. discloses markers 242 that are provided for overlapping graphics 212. Specifically, Hirokazu et al. describes a marker control unit 160 that prepares markers for graphics detected by the overlap detection unit 140. Applicant notes with reference to Figure 10, for example, that there is no associated marker for graphic 213, which does not overlap any other graphic. Lines connecting corresponding markers and graphics are concurrently displayed with the graphics. By selecting one of the displayed markers, the corresponding graphic can be selected. This enables the corresponding graphic to be selected even when it is completely covered by other graphics, without changing the order in which these graphics are overlaid. See, e.g., paragraph [0028] of USPTO translation. Hirokazu is quite different from the subject matter disclosed in the instant application in which, for example, reduced-size images are not overlaid.

Page 4 of the office action states:

Furthermore, because the second area of Morris is on the left side of the screen (figure 10 B, items 803) and reduce-size (sic) image of Hirokazu is on the right of icon, (figure 12, items 250 and 242) therefore the combination Morris Hirokazu would create a system where each file icon is between its corresponding reduced-size image and the second area of the display screen.

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Applicant traverses these contentions. Independent claim 1 specifies that the file icon has a smaller area than the reduced-size image. Thus, in Hirokazu et al., marker 242 would nominally correspond to a file icon and graphic 212 would nominally correspond to the reduced-size image. In this case, contrary to the assertion in the office action, the reduced-size image would be between the file icon and the second area on the left side of the display screen in Morris et al. Consequently, the proposed combination of Hirokazu et al. and Morris et al. would not result in the subject matter of claim 1 as alleged in the office action.

Moreover, Hirokazu et al. contains no description of function icons and thus can provide no teaching or suggestion as to how file icons/reduced-size images should be positioned relative to such function icons.

Further, there is no apparent reason for modifying Morris et al. as proposed in the office action. Specifically, Hirokazu et al. provides markers to deal with problems associated with overlapping graphics. Applicant does not find, and the office action does not identify, any such problem in Morris et al. that would be solved using the markers of Hirokazu. The office action conjectures that combining Hirokazu and Morris et al. would "simplify presentation and selection of images over the web." No explanation is offered as to why such simplifying would result from the proposed combination, nor is any such explanation apparent.

The office action further notes:

Morris' users cannot easily recognize the correspond (sic) of a window and display on a window and a display on a window graph corresponding to the window because the display window and the window graph are displayed at separated positions. Therefore it would be obvious to combine Hirokazu's teaching with Morris' method. 5/22/2006 Office Action, page 20 (emphasis supplied).

This statement actually confirms why Hirokazu et al. and Morris et al. would not be combined. Specifically, Morris et al. deals with items at separated positions and Hirokazu et al. provides a solution to a problem when items are overlapping, not separated. As noted above, in Hirokazu et al., when there is no overlap, no marker is even provided. Absent impermissible hindsight, there would have been simply no reason to combine Hirokazu et al. with Morris et al.

Independent claim 13, 24, 25, 32, 34 and 36 were rejected as allegedly being "obvious" over Morris et al. and Hirokazu, in further view of Johnston, Jr. et al. (U.S. Patent No.

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5,598,524). Like claim 1, each of independent claims 13, 24, 25, 32, 34 and 36 calls for a file icon to be between its corresponding reduced-size image and the second area of the display screen, which second area displays a function icon. Morris et al. and Hirokazu et al. are deficient in this regard for the reasons set forth above. The portion of Johnston, Jr. et al. referenced in the office action with respect to claim 13, relates to dragging an icon for a document to a printer. Johnston, Jr. et al. provides no disclosure or suggestion whatsoever with regard to reduced-size/file icons pairs or the arrangement of such pairs relative to function icons. Thus, the addition of Johnston, Jr. et al. to the proposed Morris et al.-Hirokazu et al. combination could not have resulted in the subject matter of claims 13, 24, 25, 32, 34 and 36.

The various other secondary documents do not remedy the deficiencies of Morris et al. and Hirokazu et al. with respect to the independent claims.

Applicant also strongly contests the various rejections of the dependent claims. The documents applied in connection with these dependent claims simply do not disclose or suggest the specific dependent claim features.

By way of example, claim 2 is directed to an aspect of dragging the file icon. Namely, if the drag operation is performed at a speed equal to or greater than a predetermined speed, the reduced-size image is fixed at a current position while a drag operation is performed. If the drag operation is performed at a speed below the predetermined speed, a frame having the size of the reduced-size image is displayed. Johnston, Jr. et al. and Belfiore et al. are applied in connection with this feature.

Johnston, Jr. et al. describes that a shape such as a rectangle may be used to represent a dragged object. However, Johnston, Jr. et al. does not relate this operation to the speed of dragging in any way, nor does Johnston, Jr. et al. disclose how the appearance of a reduced-size image should vary when a corresponding file icon is dragged. Belfiore et al. describes that an auto-scrolling operation may be made to depend on the speed of a mouse indicator during a drag-and-drop operation. Here again, Belfiore et al. does not disclose or even remotely suggest how the appearance of one object should change based on the appearance of some other object such as a file icon. There is no possibility that the subject matter of claim 2 could have been derived from these documents.

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By way of further example, claims 5-7 and 11 are directed to the concept of an icon return space. The subject application describes by way of example without limitation that when a file icon is dropped in an icon return space, the file icon is moved back to its original display position without moving the associated reduced-size image. See, e.g., page 9, line 25 to page 10, line 5. The office action alleges that dotted line in Figure 7 of Hirose et al. illustrates an icon return space. Even assuming for the sake of argument that this portion of Hirose et al. is alleged to constitute an icon return space, there is no disclosure in Hirose et al. of displaying such a space based on the distance of the file icon from a corresponding reduced-size image.

Additional bases for patentability are presented in the prior responses, which are incorporated herein by reference.

For at least these reasons, Applicants respectfully submit that the rejections of the pending claims are improper and should be withdrawn.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: \_\_\_\_\_



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